IN THE UNTIED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of	§	
BILL L. DAVIS and	§	
JESSE S. WILLIAMSON	§	
	§	
For Reissue of U.S. Patent 5,630,363	§	Group Art Unit: 2854
Issued May 20, 1997	§	
Serial No. 08/515,097	§	
	§	
Filing Date: May 20, 1999	§	Examiner: Joshua D. Zimmerman
	§	
For: COMBINED LITHOGRAPHIC/	§	
FLEXOGRAPHIC PRINTING	§	
APPARATUS AND PROCESS	§	

SUPPLEMENTAL DECLARATION OF BILL L. DAVIS UNDER 37 C.F.R. 1.131

I, Bill L. Davis, declare and state as follows:

1. I am a co-inventor, along with Jesse S. Williamson (hereinafter, "Jesse" or "Jesse Williamson"), of one or more of the claimed inventions of U.S. Patent 5,630,363 (hereinafter, "the '363 patent") and the co-applicant of the above-captioned reissue application. At all times relevant hereto, I and Jesse Williamson were employed, and are still employed, by Williamson Printing Corporation of Dallas, Texas (hereinafter, "WPC"), the assignee of the '363 patent and of this reissue application.

2. It is my understanding that the Hartung, et. al. Patent 5,638,752 ("*Hartung*) is being cited by the Patent Examiner as barring the allowance of a number of the claimed inventions in our reissue application. Specifically, it is my understanding that the Patent Examiner contends that because *Hartung* (i) has a U.S. priority date of April 4, 1994, and (ii) teaches a plurality of successive, in-line printing stations with one or more flexographic printing stations upstream from an offset lithographic printing station, *Hartung* would be prior art barring such allowance. However, Jesse Williamson conceived this very teaching as his

invention long prior to this April 4, 1994 date. It is therefore the principal purpose of this declaration to provide my corroboration of Jesse Williamson's conception prior to April 4, 1994, as well as to succinctly summarize in one document proof, including submission of additional demonstrative evidence, in support of our diligence in reducing Jesse's invention to practice between the time period of just before April 4, 1994 until August 14, 1995, the filing date of the application for the '363 patent. I also by this declaration reaffirm all the statements I have made in prior declarations filed in this matter.

3. To begin with, my designation as a joint inventor is due to my conception of certain features that are recited in some of the narrower claims of the '363 patent. These include having the in-line upstream flexographic printing station(s) incorporate certain structural elements that make up an offset type flexographic printer, as recited in dependent claims 9 and 11 or independent claim 17, for example. However, Jesse Williamson is the sole inventor of the basic concept of the patented invention, namely printing apparatus, and a method of using such apparatus, in which successive flexographic and offset lithographic printing units or "stations" are arranged for continuous in-line printing of a substrate in a single pass, with the flexographic printing station or stations upstream from an offset lithographic printing station. My personal knowledge of his conception of this invention, and that such conception was long prior to April 4, 1994, is now detailed by me.

4. Specifically, after Jesse Williamson returned to Dallas, Texas from a business trip to Germany in late May 1992, Jesse disclosed his idea to me at the offices of WPC, sought my opinion as to its merits, and requested my assistance in further developing this concept into an operating system. Jesse explained that it had long been an objective of his to find a better way to increase the intensity of metallic colors and the opaqueness (whiteness) of printed images

without increasing the time and expense of the printing process. He believed that the key to achieving this objective was to have a printing process that provided sufficiently large densities (volume and size) of printing ink to enable a one pass operation, but that it was not until his recent trip did it occur to him how that could be achieved, given the other conditions that must be adhered to. He then went on and stated that initially his idea was to incorporate either a flexographic type printer or a gravure type unit upstream from an offset lithographic type printer in a continuous in-line arrangement. However, before he arrived back in Dallas, he had discarded the idea of using a gravure unit and considered a flexographic type printer to be the more practical choice. I remember Jesse stating that for the purpose of integrating the upstream flexographic unit with the offset lithographic unit, he was contemplating using either an arrangement in which a tower coater with an anilox roller, a well-known means for implementing a flexographic printing process, would serve as a dedicated upstream flexographic printing station with the offset lithographic printing station, or alternatively using an auxiliary add-on flexographic unit. In either alternative, he was planning on incorporating a drying station between the flexographic printing station and the downstream lithographic station. The substrate to be printed upon would make a single pass through the flexographic unit, the ink on the substrate thereafter dried, then followed by the substrate's passage through the lithographic printing unit.

5. We then discussed the auxiliary add-on alternatives. The auxiliary add-on alternatives suggested by Jesse Williamson included using a bolt-on device similar to a "T" head, lowering apparatus with an anilox roller assembly by rail to the lithographic station, or moving the flexographic unit sideways into, and forward of, the lithographic station. I indicated to Jesse that, in my opinion, an auxiliary add-on was the most practical, and that I thought the best

approach would be "rack-back" units that were on the market, modified for multiple station use and equipped with an anilox roller and doctor blade assembly. Jesse and I then made several sketches of how this "rack-back" device could be potentially built in order to implement Jesse's idea.

6. With regard to the diligence in reducing Jesse's invention to practice, as of April 4, 1994, Williamson Printing was still engaged in a lengthy study and negotiations to determine what type lithographic presses WPC should purchase, and from which manufacturer, to replace its then outdated fleet of lithographic sheet and web presses. This study also included what equipment WPC would also need to purchase to implement the invention. The difficulty facing us was that WPC is only a printing company and did not, and still does not, itself produce either printing presses or auxiliary equipment, including the auxiliary equipment that needed to be integrated with the company's lithographic press units to reduce the invention to practice. Instead, we must rely solely upon what printer apparatus or auxiliary equipment is on the market from the various manufacturers or what custom units it can convince a press or auxiliary equipment manufacture to build. During this study period, WPC narrowed the list of press manufacturers from which it would purchase its new lithographic presses to Komori, MAN-Roland, and Heidelberg. As a consequence of negotiations extending from 1993 through early 1994, WPC ordered five offset lithographic sheet presses from Heidelberg USA in July 1994 (and at a later time, two additional lithographic web presses from MAN–Roland.)

7. Now that we had the offset lithographic presses we needed, our next step in reducing our invention to practice was to implement the in-line integration of the upstream flexography print station with the lithographic print unit. Of course, there was no lithographic press equipment on the market with an upstream dedicated flexographic print station. Therefore,

the auxiliary "add-on" approach was our most expedient solution. For this purpose, we approached Printing Research, Inc. ("PRI"), initially PRI's salesman, Steve Baker, in late July 1994, and thereafter John Bird of that company, to determine PRI's interest in designing and selling to WPC a retractable, "rack-back" mechanism, modified with an anilox roller and a chambered doctor to provide the flexographic printing process, that could be integrated with the WPC lithographic printing unit. PRI accepted the project, but it was not until October and December 1994, that testing of a completed prototype of the mechanism was carried out at PRI's facility, with WPC thereafter running the printed product through its multi-color lithographic presses to confirm suitability of the final product.

8. In the meantime, due to PRI's delays, and not knowing whether PRI would be able to satisfy our objectives, or whether they would be price competitive with its final production model of its modified rack-back, beginning in the summer of 1994 we pursued a parallel track with Heidelberg to determine their ability to provide a print lithographic apparatus with a dedicated flexography unit. In that regard, Heidelberg in January 1995 first conducted an off-line test of the inventive process. By early February 1995, Jesse and I had decided that the most expedient approach was to stick with the modified rack-back design from PRI, rather than await a dedicated station from Heidelberg. Notwithstanding, it was not until September 1995 that PRI was able to deliver an auxiliary unit sufficient to enable us to actually reduce the invention to practice.

9. However, long before the September actual reduction to practice, we commenced activity to patent the invention. Specifically, in December 1994, we engaged the services of the law firm of Jones, Day, Reavis & Pogue, to take such steps as were necessary to protect the invention under the United States patent laws. On January 11, 1995, Mr. Alfred E.Hall, a patent

agent with that firm, sent me a letter, a copy of which is attached as Exhibit 1 hereto, confirming what was his understanding at the time of our combined flexographic/lithographic in-line process. Thereafter, Mr. Hall initiated a patent search in late January 1995, and upon receiving the search results, forwarded the search report and prior art patents to me in March 1995. Thereafter, during March, I reviewed and studied, and discussed with Jesse, the prior art patents turned up in Mr. Hall's search. After confirming that the invention was not disclosed by any of these prior art patents, I called to set up an appointment with Mr. Hall to begin the patent application drafting process. In April 1995, Jesse Williamson and I met with Mr. Hall to discuss additional details of the invention, and to authorize him to proceed with preparation of the patent application. Then, as evidenced by the privilege log attached as Exhibit 2, from early May 1995 until the filing of our application for the '363 patent on August 14, 1995, we exchanged alternate drafts and redrafts of the application, with the final draft approved by us for filing on August 14, 1995.

10. The undersigned Declarant states that all statements made herein of Declarant's own knowledge are true, and that all statements on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Date: 5-29-2008

Bill L. Davis

Bill L. Davis